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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,592	09/29/2004	Shintaro Nishida	2004-1559A	5908

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EXAMINER

BOYKIN, TERRESSA M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,592

Applicant(s)

NISHIDA ET AL.

Examiner

Terressa M. Boykin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Response to Arguments

Applicant's arguments filed 2-22-06 have been fully considered but rendered moot in view of a subsequent search and new rejection set forth below.

It should be noted that applicants' claim 1 remains so broadly set forth that the claim continues to be interpreted by the Examiner as anticipated by various prior art while remaining within the scope of the specification. It should be noted that in order to prosecute the case resourcefully and expediently while giving the applicants the best possible search, it is imperative and practical for the applicants to clarify how the optical disk substrate which employs a commonly known monomeric moiety differs from that of the various polycarbonates used to produce optical disks. Without such clarity of structure, the art of record remains within the scope of the present claims and the Applicant's arguments although understood and appreciated are moot on those basis.

**** It would be beneficial and helpful for the applicants in order to expedite the prosecution of the case to be in position of allowability by using language from the specification (i.e. page 1, paragraph 1 second sentence) or drawn directly from the examples of the specification that would clearly and further specify the claimed language without, of course, unfairly limiting applicants intended invention.***

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the

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international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-23 are rejected under 35 U.S.C. 102(b or e) as being anticipated by USP 6908655 see abstract, figures. Cols. 1-8 and claim 1; USP 6447868 see cols. 1-6.

USP 6908655 discloses a disc-shaped recording medium having transcription characteristics for fine signals simultaneously with resonance characteristics and stiffness, which are characteristics contrary to the transcription characteristics. At least a recording layer and a light transmitting layer are sequentially formed on a substrate and light is illuminated from a light transmitting layer side to record and/or reproduce information signals. The substrate includes a core layer formed of a resin composition comprised of a mixture of two or more resin sorts. The resin composition has $\tan\delta$, as an index indicating the internal loss, equal to not less than 0.015 as a system in its entirety. The resin composition constituting the core layer is a compounded resin of the incompatible system and is of an islands-sea structure.

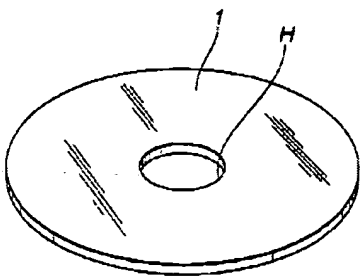


FIG.1



FIG.6

The reference discloses that the representative aromatic polycarbonate resins, used as a component A, there is a polycarbonate resin containing at least 20 mol % per 100 mol % of the entire aromatic dihydroxy component of 1,1-bis(4-hydroxyphenyl)-3,3,5-trimethyl cyclohexane, referred to below as the bisphenol TMC, represented by the formulas as used and disclosed therein.

The preferred aromatic polycarbonate resin uses at least 20 mol % and preferably 30 to 80 mol % of the aforementioned bisphenol TMC per 100 mol % of the total quantity of the aromatic dihydroxy component. If the content of the bisphenol TMC is not less than 20 mol %, it is possible to realize the high tan. delta. value, superior vibration damping characteristics, a low water absorption coefficient and a high dimensional stability. If the content of the bisphenol TMC is this high, preferably the terminal group is modified using a specified terminal group modifier as disclosed therein.

A copolycarbonate resin, obtained on combining the specified dihydroxy component with the aforementioned bisphenol TMC, is particularly suited as

thermoplastic resin exhibiting vibration damping characteristics. That is, such copolycarbonate as contains at least 80 mol % per total amount of 100 mol % of the aromatic dihydroxy component of (a) bisphenol TM (component a) and (b) at least one aromatic dihydroxy component selected from 4,4'-(m-phenylene diisopropylidene) diphenol, referred to below as bisphenol M, represented by the formula as disclosed in col. 7 etc.

No particular limitation is imposed on the field of the optical molding materials according to the reference, and they may be used over a wide range. More specifically, they may be particularly suitably used as lenses such as spectacle lenses, lenses for general cameras, pickup lenses, lenses for video cameras, telescope lenses and lenses for laser beams; optical disks as recording media capable of reading, writing, or reading and writing information using light (including laser beams) over a wide range, for example, as memory disks, such as optical video disks, audio disks such as compact disks (CD), minidisks (MD) and DVD, phase change type disks, magneto-optical disks (MO), GIGAMO disks, CD-ROM disks, CD-R disks, DVD-RAM disks, DVD-ROM disks, DVD-R disks, and disks for video recording; optical films such as phase difference films, deflection films, transparent conductive films and OHP films; optical materials such as light diffusion plates, light guide plates and liquid crystal display substrates; sealants for optical semiconductors such as photo-interrupters, photocouplers, LED lamps; sealants for IC memories such as IC cards; and optical fibers. Among these, they may be suitably used as the optical disks because they exhibit far excellent

properties therefor.

USP 6447868 discloses an optical molding material, and an optical disk substrate and a production method thereof, and more particularly to an optical molding material which is high in transfer accuracy and toughness, small in birefringence, particularly, birefringence occurred in a thickness wise direction, good in optical disk properties and free of occurrence of silver streak, or to an optical molding material which is small in the variation range of retardation depending on light wavelength and good in optical properties when it is molded into an optical disk substrate by injection molding in particular, and also to an optical disk substrate making use of such a molding material, and further to a production method of an optical disk substrate which is free of occurrence of silver streak upon its production, high in transfer accuracy and toughness, small in warpage, narrow in scatter of birefringence properties, particularly, concyclic birefringence, and good in optical disk properties.

Since the disclosed viscosity and molecular weight, although present in the reference, are expressed differently, they may be distinct from those claimed, thus it is incumbent upon applicant(s) to establish that they are in fact different and whether such difference is unobvious. Any properties or characteristics inherent in the prior art, e.g. particularly defined grooves and pits, although unobserved or detected by the reference, would still anticipate the claimed invention. Note *In re Swinehart*, 169 USPQ 226. "It is

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elementary that the mere recitation of a newly discovered...property, inherently possessed by things in the prior art, does not cause claim drawn to those things to distinguish over the prior art". Each of the compositions or polycarbonate moieties are known to be used as a light guide plate as in disc or DVD operations. In view of the above, there appears to be no significant difference between the reference(s) and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (571-272-1700).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb


Examiner Terressa Boykin
Primary Examiner
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